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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,515	02/23/2001	Tetsuro Wada	1900/00021	8620

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EXAMINER	
GRAY, JILL M	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/763,515	WADA ET AL.	
	Examiner	Art Unit	
	Jill M. Gray	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2006 and 27 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The indicated allowability of claims 22-27 is withdrawn upon further consideration.

Drawings

1. The drawings were received on January 27, 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-15, 20, and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, in claims 11 and 14, the language of "a member contacting said core member" and in claims 12 and 15, the language of "thread contacting said core member" is vague because the term "contacting" does not clearly define the structural relationship of the core member and member (claim 11) or core member and thermal welding thread (claim 12). Also, in claim 11 the "member" contacting said core member is vague and indefinite and does not provide a clear positive recitation of what is in contact with the core member. Accordingly, the metes and bounds for which patent protection is being sought are not clear.

In claims 10-15, the language of "covering said core member" is vague. This language does not provide a clear recitation of the structural relationship of the cover

member and the core member. The term "covering" embraces configurations that include being directly adjacent to and in contact with the core member as well as a configuration of an outer coating with multiple layers and components between the cover member and core member. Thus, the metes and bound for which patent protection is being sought are not clear.

Claim 20 is indefinite because this claim contains the trademark "PERMALLOY". If a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. Therefore, the metes and bounds for which patent protection is being sought are not clear.

In claim 22, the language of "preparing a core member" is vague because this language does not adequately describe the processing steps that constitute the preparation of the core member, particularly, when the core member can be two different entities, thereby implying differing processing steps. Moreover, when the core member is a fiber and a core thread, the language of "preparing a core member" is vague and indefinite. In addition, the language of "covering a periphery of said core member" is vague because this language does not clearly describe the processing steps that constitute "covering". Hence, the metes and bounds for which patent protection is being sought are not clear.

Claim 23 is vague and indefinite for the reasons set forth above in claim 22.

Claim 24 is vague and indefinite for the reasons set forth above in claim 22. Also, the language of "disposing a member to be in contact with said core member" is vague because the language of "disposing" does not adequately describe the processing steps that constitute the placing of said member. Additionally, the language of "to be in contact with" is vague also. Further, this "member" is not defined. Accordingly, the metes and bounds for which patent protection is being sought are not clear.

Claims 25-27 are vague and indefinite for reasons stated above in claims 22 and 24.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 10-11, 13-14, 16, 20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litman 5,988,500 and 6,053,406, (referred to collectively as Litman '500).

Litman teaches elongated magnetic elements which are inserted into items. See abstract, ('500). The elongated elements can be fibers, intertwined fibers, threads or strips and can be placed within a nonmetal cover material, per claims 10, 13, 22 and 23. Or more specifically, a core member and a covering member made of a nonmetal material covering said core member. See column 4, lines 9-13, column 5, lines 15-26,

and column 11, line 51 through column 12 and line 8. As to the preamble language of "security thread", this language is not found to be limiting to the present claims because the body of each claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. Litman additionally teaches that the elongated magnetic elements can be made from a soft magnetic material of the type contemplated by applicants, such as "PERMALLOY", as required by claims 16 and 20, further teaching that a member of semi-hard magnetic material can be in contact with the core member, per claims 11, 14, 24 and 25. See column 16, lines 39-42. Litman is silent as to the permeability of his magnetic material. Nonetheless, Litman discloses the same type of soft magnetic material as that disclosed by applicants as being suitable. Therefore, the examiner has reason to believe that the permeability of the magnetic material taught by Litman is the same as or within applicants' presently claimed range.

Therefore, the teachings of Litman would have rendered obvious the invention as claimed in present claims 10-11, 13-14, 16, 20, and 22-25.

5. Claims 17-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litman 5,988,500 and 6,053,406 (collectively referred to as Litman '500), as applied above to claims 10-11, 13-14, 16, 20, and 22-25, in view of Dames et al, 5,614,824 (Dames).

Litman is as set forth above but does not teach the specific composition of his soft magnetic materials. Dames teaches a security thread comprising a plastic substrate coated with a soft magnetic material. The soft magnetic materials have a

permeability of 1000 or more and include alloys of the type contemplated by applicants. See column 6, lines 23-47. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Litman by using as his soft magnetic material, a material as taught by Dames, with the reasonable expectation of success of forming security articles that demonstrate toughness and resilience to mechanical deformation while being easily magnetizable from a distance by a relatively weak applied magnetic field.

Therefore, the combined teachings of Litman and Dames would have rendered obvious the invention as claimed in present claims 17-19 and 21.

No claims are allowed.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jill M. Gray
Primary Examiner
Art Unit 1774

jmg